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New York, NY 10112

In re Application of:
Tatsuo Furukawa et al.
Serial No.: 09/374,580
Filed: August 16, 1999
Attorney Docket No.: 862.3016

DECISION ON PETITION TO
WITHDRAW THE HOLDING
OF ABANDONMENT

This is a decision on the petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181(a) filed on June 10, 2005. There is no fee for this petition.

The petition is **GRANTED**.

On May 25, 2005, a Notice of Abandonment was mailed indicating that the application was abandoned in view of the applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85). It also indicated that the issue fee was received on February 25, 2005 which was after the expiration of the statutory period for payment of the issue fee set in the Notice of Allowance (PTOL-85).

A review of the file record indicates the following:

On September 27, 2002, a Notice of Allowability and a Notice of Allowance and Fee(s) Due were mailed to applicant. The Notice of Allowability indicated that claims 38-45 were allowed. Claims 1-37 and 46-58 had been cancelled in an amendment dated July 24, 2002. The applicant paid the required issue fee on October 15, 2002.

On August 4, 2003, applicant filed a petition to withdraw the application from issue after payment of the issue fee under 37 C.F.R. § 1.313(c)(2) together with the required request for continued examination (RCE). The submission required under 37 C.F.R. § 1.114 was an information disclosure statement (IDS). The petition was granted in a decision dated August 4, 2003.

On November 10, 2003, applicant filed an amendment which amended claims 38 and 40 and added new claims 59-67. Although the amendment was entitled "PRELIMINARY AMENDMENT", since an RCE is not a new application, an amendment filed before the first Office action after the filing of the RCE is not a preliminary amendment. See MPEP §714.01(e). In any case, this amendment was unfortunately not matched with the file until after examiner

mailed a new Notice of Allowability and a new Notice of Allowance and Fee(s) Due to applicant on January 27, 2004. The new Notice of Allowability indicated that claims 38-45 were allowed. The new Notice of Allowance and Fee(s) Due indicated that an issue fee of \$50.00 was due on April 27, 2004.

On February 17, 2004, applicant filed a letter entitled "LETTER RE ERRONEOUS NOTICE OF ALLOWANCE." The letter pointed out that the claims allowed in the Notice of Allowability mailed January 27, 2004 were those that existed in the application prior to the amendment filed on November 10, 2003.

On April 27, 2004, applicant filed a letter entitled "LETTER RE WITHDRAWAL OF APPLICATION FROM ISSUE PURSUANT TO MPEP §714.15." The letter again indicated that the Notice of Allowability mailed January 27, 2004 did not refer to the claims of the amendment filed on November 10, 2003. The letter further indicated that applicant had been informed that claims 59 and 64 submitted in the amendment of November 10, 2003 had to be reviewed further before they could be allowed. The letter finally indicated that this issue fee was not being paid on April 27, 2004 with the understanding by applicant that the application would be withdrawn from issue for further examination.

On October 28, 2004, applicant resent the letter of April 27, 2004, via facsimile transmission, directly to the supervisor of the examiner.

On November 30, 2004, examiner mailed to applicant a "supplemental" Notice of Allowability which indicated that claims 38-45 and 59-67 were allowable. A corresponding Notice of Allowance and Fee(s) Due was **not** mailed with the "supplemental" Notice of Allowability.

On February 25, 2005, applicant filed a letter entitled "LETTER AUTHORIZING CHARGE OF DEPOSIT ACCOUNT FOR BALANCE OF ISSUE FEE". On March 7, 2005, the balance of the issue fee at that time was charged to applicant's Deposit Account.

CONCLUSIONS

At the time the amendment of November 10, 2003 was filed, MPEP §714.15 read in pertinent part:

"If, however, the amendment is filed in the Office prior to the mailing out of the notice of allowance, but is received by the examiner after the mailing of the notice of allowance, it has the same standing in the application as though the notice had not been mailed. Where the application has not been closed to further prosecution, as by final rejection of one or more claims, or by an action allowing all of the claims, applicant may be entitled to have such amendment entered even though it may be necessary to withdraw the application from issue. Such withdrawal, however, is unnecessary if the amendatory matter is such as the examiner would recommend for entry under 37 CFR 1.312."

Based upon this passage of MPEP §714.15, it is deemed that at the time the amendment of November 10, 2003 was filed, applicant was entitled to have the amendment entered and considered.

The Office erred in not mailing a new Notice of Allowance and Fee(s) Due when the "supplemental" Notice of Allowability was mailed on November 30, 2004. If a new Notice of Allowance and Fee(s) Due was sent with the "supplemental" Notice of Allowability, it would

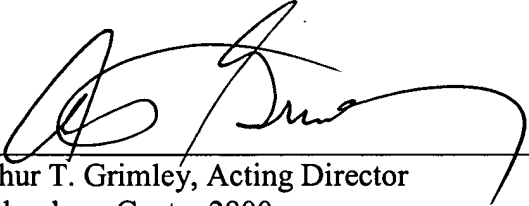
have set a new three month statutory period in order to pay the balance of the issue fee. The new three month statutory period would have expired on February 28, 2005 and the balance of the issue fee at that time that would have been due would have been \$120.00.

Applicant acted promptly and properly when he filed the letters of February 17, 2004; April 27, 2004; and February 25, 2005.

For the above stated reasons, the petition is granted. The Notice of Abandonment mailed May 25, 2005 is hereby **VACATED** and the holding of abandonment is withdrawn. The payment of the balance of the issue fee, via the letter giving authorization to charge applicant's Deposit Account for the balance of issue fee filed on February 25, 2005, is accepted as being timely.

A new Notice of Allowance and Fee(s) Due (PTOL-85) indicating a balance of "Total Fee(s) Due" of \$0 will be sent to applicant together with another copy of the "supplemental" Notice of Allowability originally mailed on November 30, 2004. As noted on the PTOL-85, "PART B – FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B – Fee(s) Transmittal should be completed and returned."

Any inquiries regarding this decision should be directed to Edward Westin at (571) 272-1638.



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